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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/711,106

08/24/2004

George J Nassef Jr

5105

43836

7590

08/20/2008

VALETNOIR INC - A NEW YORK CORPORATION

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NEW YORK, NY 10001

EXAMINER

WONG, JEFFREY KEITH

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/711,106

Applicant(s)

NASSEF, GEORGE J

Examiner

Jeffrey K. Wong

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of the Application

1. This Office-Action acknowledges the Amendment filed on 4/3/2008 and is a response to said Amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The amendment filed 4/3/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 49 discloses of users having the ability to hide or unhide certain personal attributes about their past-play, past-trips, or personal data. Claims 50-66 are dependent on claim 49.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. Claims 49-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. Claim 49 discloses of users having the ability to hide or unhide certain personal attributes about their past-play, past-trips, or personal data. Claims 50-66 are dependent on claim 49.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker USPTO 2003/0003988 (Walker) in view of Reitz, USPTO 5,649,182 (Reitz).

As to claim 49 and 63.

Walker discloses (abstract), "The invention includes a system and method for planning and customizing a gaming vacation. Initially, a central controller receives preference and configuration data from a user at a user terminal...The configuration data and the associated preparation code are transmitted from the central controller to a casino server. The central controller provides feedback regarding the user's request. The feedback may include, for example, marketing offers for the user" Walker further discloses, "(paragraph [0031]), "... a central controller communicates with multiple user devices, multiple casino servers, and multiple

marketer devices. The casino servers, in turn, are in communication with multiple casino devices, including gaming devices... a user may log onto a Web site hosted by the central controller. On the Web site, the user may prepare for his vacation by inputting a preferred gaming device configuration, choosing a betting system, selecting a group of friends with which to share winnings, and by performing or using other aspects of the invention mentioned above. The central controller may then associate all the data defining the user's preparations with a preparation code or a user identifier, such as the user's name or a player tracking card number, and store the user's preparation data in, for example, a preparation database and the user identifier in a user database." He further discloses (paragraph [0087]) that, "...o the central controller..., may comprise one or more computers..., that are connected to a remote server computer operative to maintain databases, where the data storage device..., is comprised of the combination of the remote server computer and the associated databases." Walker further discloses (paragraph [0059]) that the term "player tracking card" may refer to a device that may be capable of storing information about a consumer who is a casino player. Walker further discloses (paragraph [0106]), "The user database... provides example data to illustrate the meaning of the information stored in this database embodiment. A player identifier..., may be used to identify and index the players listed in the player database... examples of player information are provided: "Sam Brown" with credit card number "1111-1111-1111-1111" is a "male, age 23" who played on gaming device "M234" and has a lifetime theoretical win of "2,345.00"..." Walker also discloses (paragraphs [0380-0381]), "... the user may pre-configure the gaming device...to print text in his native

language... a language menu may have the choices of English, Spanish, Chinese, or Japanese... Menus may also have an "other" choice, allowing a user to select from less common choices (e.g. Swahili)..." While Walker meets the applicant's limitation of a system comprising: a self-servicing system for players where the system contains a database with data about said player, player gaming history, allowing data to be accessed by users of the system, the ability to search for a plurality of casino offers, and the ability of the system to contact casino clients, and of having players/users contact each other in their native languages, Walker fails to explicitly disclose the ability to hide or unhide certain personal, user attributes.

However, Reitz presents an apparatus and method for organizing" and filtering data, with the data records being stored in a database (abstract). Reitz discloses (column 1, lines 29-35) a system to, "...permit a user to input notes relating to a variety of identifiers at any time, and then permit the user to organize the data..." Reitz further discloses (column 14, line 66- column 15, line 11), "FIG 7., a UTILITIES menu 190 is also provided as a pull down menu. The UTILITIES menu 190 includes a" Hide Selected Item" option 192 and an" Unhide Selected Item" option 194. These two features are used in connection with the "Open Only" field 102 of FIG. 4 (or alternatively "Show Hidden" field). In One embodiment, each Table in the database, as shown in FIG. 2, contains a status indicator indicating whether the entry has an "open" status or a "closed" status. In this case, fields 192 and 194 are used to change the status of the particular entry. In an alternative embodiment, none of the Tables in FIG. 2 include such

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a status indicator field. Instead, the user may use fields 192 and 194 to either "hide" or "unhide" selected entries."

The advantage of having the hide/unhide options for items and data, Reitz writes (column 15, lines 11-13), "In this way, certain records may be hidden and other unhidden to provide another way of grouping records..."

This is evidence that one of ordinary skill in the art would have reason/motivation/suggestion to employ the use of a hide/unhide option for data on a database system for the purpose of grouping records.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the database of the Walker system with the hide/unhide option for data on databases as described by Reitz for the purpose of grouping records.

As to claim 50, as discussed above, the user may log onto a web site, which implies that the system is accessible through the Internet, and would be obvious to one of ordinary skill in the art.

As to claims 51 and 52, as discussed above Walker (paragraphs [0031] and [0106]) discuss that multiple casino servers may be employed, and provide examples of player history including gaming machines used by the user, and lifetime win history. This would meet the applicant's limitation of having historic data of the gaming player being from other properties, and limitation of historic data being the gaming history of the casino

client. Different properties sharing a central database is also referenced in Walker [0092].

As to claim 53, as discussed above in Walker, players may have a player tracking card and identifier, which includes numbers, in order to identify players. Walker discloses in paragraph [0105], that the database contains, "...a financial account identifier field...that stores a representation of a bank account number, a credit card number, or other financial account information needed to charge an account...a demographic field...that stores a representation of a description of demographic information about the user;...a machine identifier field...that stores a representation uniquely identifying a gaming device...upon which the user played;...a lifetime theoretical win field...that stores a representation of the user's lifetime theoretical win..." Walker further discloses (paragraph [0145]), "Other preparation data may include the circumstances under which a user would like to receive marketing offers. Possible circumstances include: the user has just won a payout in excess of a certain threshold; the user has accumulated winnings in excess of a certain threshold; the user has sustained losses in excess of a certain threshold; the user has just inserted a bill, such as a \$100 bill, into a gaming device; a particular time of day occurs, for example, the clock has struck noon and the user would like lunch offers from local restaurants; it is a particular date; particular weather conditions have transpired; and the user just pressed a button or otherwise indicated that he desires a marketing offer." This would meet the applicant's limitation of

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data being the actuals, wagering data, win/loss, property, player account number, credit line information, dates, and other gaming facts and preference data.

As to claim 54, Walker discloses (paragraph [0031]), "On the Web site, the user may prepare for his vacation by inputting a preferred gaming device configuration, choosing a betting system, selecting a group of friends with which to share winnings, and by performing or using other aspects of the invention mentioned above. The central controller may then associate all the data defining the user's preparations with a preparation code or a user identifier, such as the user's name or a player tracking card number, and store the user's preparation data in, for example, a preparation database and the user identifier in a user database." This illustrates multiple databases in use by the system--that is to say, a user database and a preparation database. More databases in use by the system are further exemplified in Walker (paragraphs [0101 - 0128]).

Regarding claims 55 and 62, Walker discloses (paragraph [0029]), "In some embodiments a user may remotely designate prizes or comps he desires. A user may remotely submit his intended travel plans, including how long he is to stay at a destination, how much he is to gamble, where he is to eat, and so on. The user may then receive marketing offers based on his intentions." Walker further discloses (paragraph [0039]), "The user has the opportunity to build anticipation prior to the vacation by planning numerous aspects before hand. He can test various gaming

device configurations to find the one that's just right. He can get his friends involved by signing them up to win if he wins. He can arrange for tokens of good luck or sentimental value (e.g. pictures of pets) to be with him at the gaming device. The user can also extend the excitement of the vacation on the other end by reviewing a scrap book and other mementos of his trip when it is documented by the casino. The user has the opportunity to optimize his playing conditions and other aspects of his vacation, without wasting precious time during the vacation. For example, a user can determine a good configuration for a gaming device in advance, and also determine where in Las Vegas to find a gaming device capable of that configuration." Walker further discloses (paragraph [0064]), "The term "preparation data" may refer to any data received from, or related to, a user that is descriptive of characteristics of the user's desires, aspirations, intentions, expectations, preferences, and/or plans related to his gambling experience or gambling vacation. In some embodiments, preparation data may include information (and/or documentation) useful in (and/or required to) fulfill the user's desires, aspirations, intentions, expectations, and/or plans. For example, preparation data may include work product, such as a completed survey form, that the user has produced in exchange for a coupon from a marketing research firm, wherein the coupon is for a free meal at the casino restaurant at which the user was planning to eat. In some embodiments, preparation data may also include configuration data." Since the preparation data is stored in the preparation database, as discussed above, it would meet the applicant's limitation of having a database system used to form a trip to a casino destination of entertainment venue near a casino. This would further meet the

applicant's limitation of having a user searching for a plurality of casino options based on their play, likes and dislikes, plans, destinations, and key items.

As to claims 56, 57, and 61 Walker discloses (paragraph [0150]), "A marketer may transmit offers to a user in a number of ways. The marketer may leave offers with the central controller...to be later transmitted to users with qualifying characteristics. The marketer may then compensate the central controller...for every offer made, for every offer accepted, etc. In some embodiments, the marketer may communicate with a user in real time via the central controller...The marketer may have real-time access data about users currently at gaming devices...or at user terminals...and may then make its own determinations as to when to make offers. In offering products to a user, the marketer may refer to a product database...The marketer may select from the database products that are priced appropriately for a user, that meet other user criteria, and/or that have excess inventory." This would meet the applicant's criteria where a gaming player is contacted based on criteria--i.e, a marketer transmits and offer (contacts user) based on selection criteria. This further meets the limitation where selection criteria is based on information contained in the database. As the marketer has real-time access to player data, and can make offers based on the data, this would further meet the applicant's limitation of users (marketers) searching based on qualifying criteria.

As to claims 58 and 59, Walker discloses (paragraph [0220]), "The user is encouraged to quit after some condition has been met. The condition might be that the user has lost

a certain amount; the user has lost on a certain number of consecutive handle pulls; the user has won a certain amount; the user has played for a certain amount of time; etc. The gaming device may strictly enforce the user-defined rule by, for example, forcibly cashing out the user and ceasing to operate so long as the user's player tracking card is inserted. Alternatively, the user device may simply encourage the user to quit, reminding him that he had intended to quit at this point. The gaming device might also suggest some alternative activities for the user. For example, the user might visit the casino's restaurant, bar, or show. An exemplary input of the user into the Web site of the central controller is, "Cash me out if I win \$100 or if I'm down \$100." This would meet the applicant's limitation of having the system compare data (user defined criteria, data relating to a player) against a rule set. This further meets the applicant's limitation of notifying when the rule set is broken, approving if all rules are applied correctly (i.e. operating when rule set is not broken), and suspending if one or more results conflict (i.e. disabling or suspending machine if rule set is broken).

As to claim 60, as discussed above and further exemplified in Walker paragraphs [0103-0106], the user database keeps track of a player's playing history which includes (Walker, paragraph [0105]), "...gaming device...upon which the user played...a representation of the user's lifetime theoretical win..." This would meet the applicant's limitation of having another database which is a Customer Management System. The Customer Management System, as defined by the applicant, is a database storing a

player's historical information.

Regarding claims 64, Walker discloses (paragraph [0161-0162]), "A user may remotely input pictures or music. For example, the user may scan a picture of himself...and send it to the central controller." This would meet the applicant's limitation of having users uploading and adding to their profile in the database a current picture of themselves.

As to claim 65, Walker discloses (paragraph [0069]), "The term "gambling circle" may refer to a group of people, at least one of whom gambles, and whose members receive benefits based on the results of the gambler... The user may sign up the friends to be part of the user's gambling circle. In some embodiments, the friends may then receive a percentage of any jackpot the user wins." As discussed above, Walker discloses that a player may be rewarded with 'comps' based on play criteria and other marketing offers. Walker also discussed gambling circles, whereby a player enters friends names, and the friends can receive part of a player's winnings. Since a player may receive offers and comps in lieu of a monetary prize, it would have been a matter of choice, well within the capabilities of one skilled in the art, to award marketing offers, including travel discounts to the group of friends a player has invited to join his gambling circle. This would meet the applicant's limitation of having users inviting other users to join groups (gambling circles) to attend a venue together based on their established play.

As to claim 66, Walker discloses (paragraph [0027]), "In some embodiments a user may be presented with and accept a marketing offer (and thus agree to fulfill any associated obligations) in exchange for casino resort discounts, coupons, complimentary ("comp") program points, free gambling credits, and/or insurance against gambling losses." This would meet the applicant's limitation of having venues contact casino clients with offers for their venues.

Response to Arguments

Applicant's arguments filed 4/3/2008 have been fully considered but they are not persuasive. Applicant contends that the Customer Management System/database used in the current application is much more broad and extensive than that this defined in Walker. The Examiner disagrees. The Applicant discloses in [para 2] of the specifications that the Customer Management System/database stores player's historical data. Walker discloses in [para 105] of a database that can be used to store "a lifetime theoretical win field that stores a representation of the user's lifetime theoretical win". That is viewed as an aspect of the player's play history, and, thus, reading on the limitation as defined in the specifications of the application.

Applicant alleges as to Examiner's comments on Claim 37, Walker is limited to gaming devices and print text in a native language. The current invention is more extensive. It involves communication far beyond Walker and interaction between players and the system. The system also has a translation function for between users that is far superior

and different from the Walker disclosure and invention. The Examiner disagrees. [para 380-381] discloses of how players have the ability to choose languages in which information is presented. [para 122] discloses of how currency can be translated between the dollar and the yen. In cases such as these, it's obvious that translation of language and currency is being undergone by the machine. It should also be obvious that there would be a default language for a gaming machine. For instance, if one were to find such a system in an English-speaking country, it's obvious that the default language for said machine would be English. Therefore, if a player selects to have information presented in Japanese, the default language, that being English, will obviously have to be translated to Japanese. It should also be noted that [para 26] discloses of how users can use the system to email friends of their winnings. It is well known in the art that email is a means in which people can interact with one another in their native languages. It is not uncommon for a user to use email to send messages in their native languages. It should also be noted that the Examiner had re-read the specifications and has found no disclosure that defines how the applicant's translation of native languages is viewed as far superior to Walker's.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey K. Wong whose telephone number is (571)270-3003. The examiner can normally be reached on M-Th 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JKW

/Scott E. Jones/

Primary Examiner, Art Unit 3714